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EXAMINER	
SALIARD, SHANNON S	
ART UNIT	PAPER NUMBER
3628	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/670,297	POWELL, KEN R.	
	Examiner	Art Unit	
	SHANNON S. SALIARD	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 November 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10 November 2008 has been entered.

2. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Response to Arguments

3. Applicant argues that the motivation of provided by the Examiner (with regards to the combination of Nemirofsky and Jovicic et al) is inapplicable to claim 1 because the modification of Jovicic et al would be less convenient for consumers because electronic means are available in Jovicic et al. However, Examiner notes that Jovicic et al also discloses that the user may elect to have the coupon mailed electronically to the user so that the user may print the coupon on the user's printing device [col 8, lines 18-40]. Combining the invention of Jovicic et al with Nemirofsky allows the electronically transmitted coupon data to be written onto a smart card so that user does not have to carry printed coupons to the store for redemption. *Thus, the combination of Jovicic et al and Nemirofsky provide a convenient method for coupon redemption as suggested in Nemirofsky [col 1, lines 48-50]. Furthermore, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable, the combination would have likely been predictable under KSR,* ***see KSR International Co. v. Teleflex***.

4. Applicant argues that the Examiner's reliance on Valencia to modify Jovicic et al is also inapplicable because there is already no necessity of redeeming paper coupons

in Jovicic et al's system. However, Examiner submits that Jovicic et al discloses, "An added feature of the invention is that the user may choose to e-mail the coupon to him or herself allowing him or her to store the coupon for a later date handling or to send it directly to the vendor's Internet node over public computer network... **If the user elects not to mail the coupon electronically, Internet Coupon Server 124 prompts the user to input 424 whether the coupon is to be printed on the user's printing device 118. If the user chooses the printing option, the Internet Coupon Server 124 sequentially transmits coupon's digital data pattern to the Internet node's CPU 104 and the Internet node's printing device 118.**" [col 8, lines 19-38]. Jovicic et al further discloses, "A person can select an electronic coupon 300 from the Internet Coupon Server 124, **print out a hard copy and redeem it at the coupon redemption center 142 (retail outlet)** or the user could send the coupon using electronic mail from the Internet Coupon Server 124 directly to the redemption center's general computing device connected into public computer network such as the Internet 122" [col 7, lines 46-52]. *Thus, Jovicic et al provides paper coupons to customers which may be redeemed. Furthermore, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable, the combination would have likely been predictable under KSR,* ***see KSR International Co. v. Teleflex***.

5. Applicant argues, with respect to claim 2, "No reasonable combination of the art of record suggests claim 2's peculiar interrelation of steps including writing coupon data

to a smart card, pursuant to transmitting, and receiving from a computer network, and reading the coupon data from the smart card at a checkout station, having circuitry configured to communicate over a computer network having a plurality of nodes one of those nodes being coupled to a telecommunications link." However, Examiner disagrees. Valencia et al discloses, "**This card would be inserted into a reader/writer terminal provided at a retailer's checkout counter. Items which are purchased are scanned and compared with items to be discounted as well as the information provided by the customer IC smart card.** After the cashier has totaled the customer's purchases, the information contained in the IC smart card would be altered accordingly." [Abstract]. Valencia et al further discloses, "Once the customer chooses his or her appropriate items, they are scanned by the scanner 60, which is in communication with the in-store central computer, to obtain the appropriate pricing information. Once obtained, this information is sent to the master reader/writer 62 which is provided at each cashier's checkout station. **Once all of the items have been scanned and totaled, the card 2 is inserted into the master reader/writer 62. The specific act of inserting the card therein would allow the master reader/writer 62 to perform a series of tests with the card, one of which relates to the search of progressive coupon information residing in the card.** Having found, or not found, this information in the card, this information is also sent to the in-store central computer system 70." [col 7, lines 49-63]. Still further Valencia et al discloses, "**As a customer in possession of the smart card 2 approaches the checkout counter of any participating store, the smart card 2 would be inserted into the proper reader/writer provided at the**

register. This reader/writer alone, or in combination with the store's main computer, would conduct a series of tests on the smart card as previously described. Additionally, the memory of the smart card 2 will have a section dedicated to accumulating individual running balances attributed to particular manufacturers or retailers who offer discount coupons. This is made possible because of the uniqueness of bar codes and because of integrating unique identification numbers as they relate to specific manufacturers and retailers participating in the system" [col 9, lines 40-53]. *Thus, Valencia et al discloses "reading coupon data with a smart card reader/writer of the checkout station."* In addition, Christensen et al discloses, "Coupons may be embedded with a bar code indicating the identification of an individual consumer along with the consumers name printed on the face of the coupon. Bar code data may be transmitted back to the SELLECTSOFT.TM. database computer 811 when coupons are redeemed at retailer 810. **Bar code data may be transmitted manually by sending redeemed coupons to coupon processing clearing house 811, or by electronically transmitting such data using a point of sale bar code data.** Coupon processing clearing house 811 may then transmit coupon redemption data and consumer ID data to SELLECTSOFT.TM. database computer 801." [col 17, lines 1-12]. *Thus, Christensen et al discloses "sending transaction data from the checkout station to the telecommunications link via the company computer network" and "sending an identification of the coupon redeemed" (Examiner interprets a bar code to be a coupon identification)*

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. **Claim 1** is rejected under 35 U.S.C. 103(a) as being unpatentable over Jovicic et al [US 5,855,007] in view of Nemirofsky [US 5,953,047], and Valencia et al [US 5,380,991].

As per **claim 1**, Jovicic et al discloses (a) transmitting to the user computer via the global computer network, data referring to the product [col 7, lines 56-64]; (b) subsequently receiving from the user computer, via the global computer network, data indicating that the user desires to receive a coupon for the product [col 8, lines 1-10]; (c) responsive to the receiving step, transmitting to the user computer via the global computer network, coupon data representative of the coupon [col 8, lines 32-39]. Jovicic et al does not explicitly disclose using an address associated with the user computer. However, Jovicic et al discloses the Internet node communicates using Internet Protocol (IP) with another computer connected to the Internet [col 5, lines 32-40, networks using IP protocol route messages based on IP address]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to

modify the invention of Jovicic et al to include using an address associated with the user computer so that the computer knows where to send the information.

Jovicic et al does not disclose (d) writing the coupon data, transmitted in step (c), into the electronic memory of the smart card. However, Nemirofsky discloses transmitting coupon data to a computer screen over a computer network and writing the coupon data into an electronic memory of a smart card [col 3, lines 17-39, col 5,lines 40-50; col 8, lines 20-24; claim 16]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Jovicic et al to include the method disclosed by Nemirofsky. Nemirofsky provides the motivation that the invention achieves real-time interactivity and is convenient for consumers [col 1, lines 48-50].

Jovicic et al does not disclose writing the coupon data into the electronic memory of a smart card with the smart card reader/writer. However, Valencia discloses a paperless coupon redemption system and method that includes a smart card and the terminal device (including card reader/writer) in communication with the card so as to write the data into the smart card and the POS reads the smart card with the reader/writer (Fig. 5). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Jovicic et al to include the method disclosed by Valencia et al. Valencia provides the motivation that the method allows a shopper to obtain the benefit of reduced prices for certain items without the necessity of redeeming paper coupons [Abstract].

8. **Claims 2-4 and 24** are rejected under 35 U.S.C. 103(a) as being unpatentable over Jovicic et al [US 5,855,007] in view of Nemirofsky [US 5,953,047], Valencia et al [US 5,380,991], and Christensen et al [U.S. Patent 5,710,886].

As per **claims 2-4**, Jovicic et al discloses (a) transmitting to the user computer via the global computer network, data referring to the product [col 7, lines 56-64]; (b) subsequently receiving from the user computer, via the global computer network, data indicating that the user desires to receive a coupon for the product [col 8, lines 1-10]; (c) responsive to the receiving step, transmitting to the user computer via the global computer network, coupon data representative of the coupon [col 8, lines 32-39].
Jovicic et al does not explicitly disclose using an address associated with the user computer. However, Jovicic et al discloses the Internet node communicates using Internet Protocol (IP) with another computer connected to the Internet [col 5, lines 32-40, networks using IP protocol route messages based on IP address]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Jovicic et al to include using an address associated with the user computer so that the computer knows where to send the information.
Jovicic et al does not disclose (d) writing the coupon data, transmitted in step (c), into the electronic memory of the smart card. However, Nemirofsky discloses transmitting coupon data to a computer screen over a computer network and writing the coupon data into an electronic memory of a smart card [col 3, lines 17-39; col 5, lines 40-50; col 8, lines 20-24; claim 16]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Jovicic et al to include the

method disclosed by Nemirofsky. Nemirofsky provides the motivation that the invention achieves real-time interactivity and is convenient for consumers [col 1, lines 48-50]. Jovicic et al does not disclose writing the coupon data into the electronic memory of a smart card with the smart card reader/writer; (e) reading the coupon data with the second smart card reader/writer of the checkout station; (f) determining if a list of products, being purchased by the user, includes data corresponding to the coupon data; and (g) if the list of products includes data corresponding to the coupon data, then crediting the user with an amount indicated by the coupon data. However, Valencia discloses a paperless coupon redemption system and method that includes a smart card and the terminal device (including card reader/writer) in communication with the card so as to write the data into the smart card and the POS reads the smart card with the reader/writer at the checkout station (Abstract; Fig. 5; col 7, lines 49-63; col 9, lines 40-53). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Jovicic et al to include the method disclosed by Valencia et al. Valencia provides the motivation that the method allows a shopper to obtain the benefit of reduced prices for certain items without the necessity of redeeming paper coupons [Abstract]. Jovicic et al does not disclose reading the coupon data; determining if a list of products includes data corresponding to the coupon data; reporting the coupon information to a clearinghouse; sending transaction data from the checkout station to the telecommunications link via the company computer network However, Christensen et al discloses transmitting to coupon data to a user computer, via a global computer network [col 8, lines 42-col 9, lines 8; see fig, 10-13]; reading the

coupon data; determining if a list of products includes data corresponding to the coupon data; reporting the coupon information to a clearinghouse; sending transaction data from the checkout station to the telecommunications link via the company computer network [col 15, lines 20-col 16, lines 26; col 17, lines 1-12]. Also, the Examiner takes Official Notice that it is old and well known in the coupon industry to credit a customer with an amount indicated by the coupon. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Nemirofsky et al to include the methods disclosed by Christensen et al including crediting the user with amount indicated by the coupon data. Valencia et al provides the motivation that the invention avoids the traditional problems in which paper coupons must be distributed by a manufacturer, retained by a customer, brought to a consumer outlet, organized at a checkout station, inspected to determine whether the coupons are expired and then redeemed at a central clearinghouse [col 2, lines 51-58].

As per **claim 24**, Jovicic et al does not disclose wherein the step of sending transaction data includes sending an identification of the coupon redeemed. However, Christensen et al discloses wherein the step of sending transaction data includes sending an identification of the coupon redeemed [col 17, lines 1-12; *Examiner interprets a bar code to be a coupon identification]*

9. **Claim 5** is rejected under 35 U.S.C. 103(a) as being unpatentable over Jovicic et al [US 5,855,007] in view of Jones [US 5,500,681], and Valencia et al [US 5,380,991].

As per **claim 5**, Jovicic et al discloses (a) viewing a plurality of available downloadable coupons, received in a packet having an address associated with the user computer in the global computer network, on the computer monitor; (b) subsequently generating an input to the computer indicating a selection of a selected coupon from the plurality of available downloadable coupons, to cause the computer to send data, corresponding to the selected coupon, into the global computer network; [col 8, lines 1-17]; (c) subsequently receiving data corresponding to the selected coupon, the received data having been transmitted using the address through the global computer network after step (b) [col 8, lines 32-39]. Jovicic et al does not explicitly disclose using an address associated with the user computer. However, Jovicic et al discloses the Internet node communicates using Internet Protocol (IP) with another computer connected to the Internet [col 5, lines 32-40, networks using IP protocol route messages based on IP address]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Jovicic et al to include using an address associated with the user computer so that the computer knows where to send the information. Jovicic et al does not further disclose receiving the coupon in a packet. However, Jones et al discloses transmitting selected coupon to a user through the use of a packet [col 4, lines 9-27 and 39-49]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Jovicic et al to include the method disclosed by Jones et al to transmit longer messages more efficiently and reliably.

Jovicic et al does not disclose causing the received data to be written to an electronic memory of the smart card; and (d) presenting the smart card to a smart card reader/writer at the store while purchasing a product corresponding to the coupon; (e) whereby the store applies a credit specified by the data, written to the smart card in step (c), to a purchase price of the product. However, Valencia et al discloses a paperless coupon redemption system and method in which a coupon data is retrieved from an electronic memory of a smart card and presented to a reader/writer while purchasing a product at a store [col 3, lines 14-30; col 9, lines 40-53]. Also, the Examiner takes Official Notice that it is and well known in the coupon industry to credit a customer with an amount indicated by the coupon. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Jovicic et al to include the disclosed by Valencia et including crediting a customer with an amount indicated by the coupon. Valencia et al provides the motivation that the invention avoids the traditional problems in which paper coupons must be distributed by a manufacturer, retained by a customer, brought to a consumer outlet, organized at a checkout station, inspected to determine whether the coupons are expired and then redeemed at a central clearing house [col 2, lines 51-58].

10. **Claims 6 and 22** are rejected under 35 U.S.C. 103(a) as being unpatentable over Valencia et al [U.S. Patent 5,380,991] in view of Jovicic et al [US 5,855,007] and Nemirofsky et al [U.S. Patent No. 6,505,773].

As per **claim 6**, Valencia et al discloses (a) a processor in bi-directional communication with a computer network [col. 4 lines 14-15, the host computer or computer system being coupled to the smart card: col 8, lines 15-19]; (b) a smart card reader/writer circuit, in communication with the processor, capable of writing data to a smart card [see col. 4, lines 4-26; col 6, lines 29- 30 for using reader/writer]; and (c) program instructions that receive a user selection, and cause the processor to write data that is received via the global computer network into an electronic memory of a smart card via the smart card reader/writer circuit [col 3,lines 14-30; col. 4,lines 30-36]. Valencia et al does not teach program instructions that receive coupon data having been transmitted through the global computer network after the program instructions send the corresponding selection through the global network. However, Jovicic et al discloses transmitting to the user computer via the global computer network, data referring to the product [col 7, lines 56-64]; subsequently receiving from the user computer, via the global computer network, data indicating that the user desires to receive a coupon for the product [col 8, lines 1-10] and (c) responsive to the receiving step, transmitting to the user computer via the global computer network, coupon data representative of the coupon [col 8, lines 32-39]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Valencia et al to include the method disclosed by Jovicic et al. Jovicic et al provides the motivation that the invention that consumer significantly decrease the amount of time and effort expended in locating, clipping, and assembling of coupons [col 2, lines 20-39]. Valencia et al does not disclose causing the processor to write coupon data from

the user computer into the electronic memory of a smart card. However, Nemirofsky discloses transmitting coupon data to a computer screen over a computer network and writing the coupon data onto a smart card [col 3, lines 17-39; col 5, lines 40-50; col 8, lines 20-24; claim 16]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Jovicic et al to include the method disclosed by Nemirofsky. Nemirofsky provides the motivation that the invention achieves real-time interactivity and is convenient for consumers [col 1, lines 48-50].

As per **claim 22**, Valencia et al does not teach wherein the program instructions include a web browser for the World Wide Web. However, Jovicic et al discloses that a user can select a coupon for a product by browsing the Internet [col 8, lines 32-39]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Valencia et al. Jovicic et al provides the motivation that the invention that consumer significantly decrease the amount of time and effort expended in locating, clipping, and assembling of coupons [col 2, lines 20-39].

11. **Claims 7 and 23** are rejected under 35 U.S.C. 103(a) as being unpatentable over Christensen et al [U.S. Patent 5,710,886] in view of Jovicic et al [US 5,855,007], Nemirofsky [US 5,953,047], and Valencia et al [US 5,380,991].

As per **claim 7**, Christensen et al discloses (a) a processor in bi-directional communication with a global computer network [Fig. 2; col 7, lines 46-60]; and a checkout station, for reading the coupon data stored on the smart card held by a user,

including: (a) a cash register; (b) a processor in communication with the cash register and with a telecommunications link [see Fig. 2]; (d) retail program instructions that execute the steps of: (i) reading coupon data on the smart card with the second smart card reader/writer; (ii) determining if a list of products, being purchased by the user, includes data corresponding to the coupon data; (iv) reporting the coupon to a coupon clearinghouse via the telecommunications link [col 15, line 20-col 16, line 26]. Christensen et al does not disclose (c) user program instructions that receives a user selection, sends the received selection through the global computer network, receives coupon data corresponding to the selection, the received coupon data having been transmitted through the global computer network after the program sends the corresponding selection through the global computer network. However, Jovicic et al discloses transmitting to the user computer via the global computer network, data referring to the product [col 7, lines 56-64]; subsequently receiving from the user computer, via the global computer network, data indicating that the user desires to receive a coupon for the product [col 8, lines 1-10] and (c) responsive to the receiving step, transmitting to the user computer via the global computer network, coupon data representative of the coupon [col 8, lines 32-39]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Christensen et al to include the method disclosed by Jovicic et al. Jovicic et al provides the motivation that the invention that consumer significantly decrease the amount of time and effort expended in locating, clipping, and assembling of coupons [col 2, lines 20-39]. Christensen et al does not disclose causing the processor to write the coupon

data that is received via the global computer network into an electronic memory of a smart card via the first card reader/writer. However, Nemirofsky discloses transmitting coupon data to a computer screen over a computer network and writing the coupon data into an electronic memory of a smart card [col 3, lines 17-39; col 5, lines 40-50; col 8, lines 20-24; claim 16]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Christensen et al to include the method disclosed by Nemirofsky. Nemirofsky provides the motivation that the invention achieves real-time interactivity and is convenient for consumers [col 1, lines 48-50]. Furthermore, Valencia discloses a paperless coupon redemption system and method that includes a smart card and the terminal device (including card reader/writer) in communication with the card so as to write the data into the smart card and the POS reads the smart card with the reader/writer (Fig. 5). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Christensen et al to include the method disclosed by Valencia et al. Valencia provides the motivation that the method allows a shopper to obtain the benefit of reduced prices for certain items without the necessity of redeeming paper coupons [Abstract]. Christensen et al does not disclose (iii) if the list of products includes data corresponding to the coupon data, and then crediting the user with a refund of an amount indicated by the coupon data. However, the Examiner takes Official Notice that it is and well known in the coupon industry to credit a customer with an amount indicated by the coupon. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Christensen et al to

include the disclosed by Valencia et al including crediting a customer with an amount indicated by the coupon. Valencia et al provides the motivation that the invention avoids the traditional problems in which paper coupons must be distributed by a manufacturer, retained by a customer, brought to a consumer outlet, organized at a checkout station, inspected to determine whether the coupons are expired and then redeemed at a central clearing house [col 2, lines 51-58].

As per **claim 23**, Christensen et al does not disclose wherein the user program instructions include a web browser for the World Wide Web. However, Jovicic et al discloses that a user can select a coupon for a product by browsing the Internet [col 8, lines 32-39]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Christensen et al. Jovicic et al provides the motivation that the invention that consumer significantly decrease the amount of time and effort expended in locating, clipping, and assembling of coupons [col 2, lines 20-39].

12. **Claims 8-10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Jovicic et al [US 5,855,007] in view of Nemirofsky [US 5,953,047], and Valencia et al [US 5,380,991] as applied to claim 1 above, and further in view of "Bell Atlantic Introduces Interactive Yellow Pages" by Jennifer Bono (hereinafter referred to as 'Bono').

As per **claim 8**, Jovicic et al does not disclose wherein the step of transmitting data referring to a product includes transmitting hypertext, and the step of receiving is

performed after the user computer selects the hypertext by invoking a web browser for the World Wide Web. However, Bono discloses advertisers that provide links to coupons [pg. 1, para. 5 – pg. 2, para 1]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Jovicic et al to include the method disclosed by Bono to allow a user to easily navigate the site.

As per **claim 9**, Jovicic et al further discloses wherein the step of transmitting coupon data is performed after the user computer sends an email address [col 8, lines 10-17].

As per **claim 10**, Jovicic et al further discloses wherein the step of transmitting data referring to a product includes transmitting a Form, and the step of receiving is performed after the user computer invokes the Form [col 10, lines 21-45; Examiner interprets standard information (i.e., information from coupon database fields along with name, ID number, Internet address, etc.) that is displayed as part of the coupon for user's perusal to be a Form].

13. **Claims 11-19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Jovicic et al [US 5,855,007] in view of Nemirofsky [US 5,953,047], Valencia et al [US 5,380,991], and Christensen et al [U.S. Patent 5,710,886] as applied to claims 2-4 above, and further in view of "Bell Atlantic Introduces Interactive Yellow Pages" by Jennifer Bono (hereinafter referred to as 'Bono').

As per **claims 11, 14 and 17**, Jovicic et al does not disclose wherein the step of transmitting data referring to a product includes transmitting hypertext, and the step of

receiving is performed after the user computer selects the hypertext by invoking a web browser for the World Wide Web. However, Bono discloses advertisers that provide links to coupons [pg. 1, para. 5 – pg. 2, para 1]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Jovicic et al to include the method disclosed by Bono to allow a user to easily navigate the site.

As per **claims 12, 15, and 18**, Jovicic et al further discloses wherein the step of transmitting coupon data is performed after the user computer sends an email address [col 8, lines 10-17].

As per **claims 13, 16, and 19**, Jovicic et al further discloses wherein the step of transmitting data referring to a product includes transmitting a Form, and the step of receiving is performed after the user computer invokes the Form [col 10, lines 21-45; Examiner interprets standard information (i.e., information from coupon database fields along with name, ID number, Internet address, etc.) that is displayed as part of the coupon for user's perusal to be a Form].

14. **Claims 20-21** are rejected under 35 U.S.C. 103(a) as being unpatentable over Jovicic et al [US 5,855,007] in view of Jones [US 5,500,681], and Valencia et al [US 5,380,991] applied to claim 5 above, and further in view of "Bell Atlantic Introduces Interactive Yellow Pages" by Jennifer Bono (hereinafter referred to as 'Bono').

As per **claim 20**, Jovicic et al does not disclose wherein the step of viewing includes viewing hypertext by invoking a web browser for the World Wide Web.

However, Bono discloses advertisers that provide links to coupons [pg. 1, para. 5 – pg. 2, para 1]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Jovicic et al to include the method disclosed by Bono to allow a user to easily navigate the site.

As per **claim 21**, Jovicic et al further discloses wherein generating an input includes invoking a Form, and entering an email address [col 8, lines 10-17; col 10, lines 21-45; Examiner interprets standard information (i.e., information from coupon database fields along with name, ID number, Internet address, etc.) that is displayed as part of the coupon for user's perusal to be a Form].

Conclusion

15. This is a RCE of applicant's earlier Application No. 10/670,297. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHANNON S. SALIARD whose telephone number is (571)272-5587. The examiner can normally be reached on Monday - Friday, 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Hand delivered responses should be brought to the Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314

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